

Doc Code:

PTO/SB/17 (01-08)

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Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
for FY 2006☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) \$500.00

Complete if Known

Application Number	10/671,758
Filing Date	September 26, 2006
First Named Inventor	PRADEL, Jean-Laurent et al
Examiner Name	Patterson, Marc A
Art Unit	1772
Attorney Docket No.	FR-AM 1888 NP

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METHOD OF PAYMENT (check all that apply)

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Small Entity	
Fee (\$)	Fee (\$)
50	25
200	100
360	180
Multiple Dependent Claims	
Fee (\$)	Fee Paid (\$)

Total Claims Extra Claims Fee (\$)

- 20 or HP = _____ x \$50.00 = \$0.00

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims Extra Claims Fee (\$)

- 3 or HP = _____ x \$200.00 = \$0.00

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listing under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets Extra Sheets Number of each additional 50 or fraction thereof Fee (\$)

- 100 = 0 / 50 0 (round up to a whole) x \$250.00 = \$0.00

4. OTHER FEE(S)

Non-English specification. \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Notice of Appeal

\$500.00

SUBMITTED BY

Signature

Registration No.
(Attorney/Agent)

42,118

Telephone

215-419-7314

Name (Print/Type)

Thomas F. Roland, Esq.

Date

9/26/2006

This collection of information is required by 37 CFR 1.138. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/33 (07/05)

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U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) FR-AM1888 NP	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR		Application Number 10/671,758	Filed 9/26/2003
on <u>September 26, 2006</u>		First Named Inventor PRADEL, Jean-Laurent et al	
Signature <u>Michele T. Muller</u>		Art Unit 1772	Examiner Patterson, Marc A
Typed or printed name <u>Michele T. Muller</u>			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>Thomas F. Roland, Esq.</u> Signature	
<input type="checkbox"/> applicant/inventor.		Thomas F. Roland, Esq. Typed or printed name	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		215-419-7314 Telephone number	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,110</u>		September 26, 2006 Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			

☒ Total of 3 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1460, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


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I hereby certify that this paper (along with any paper referred to as being transmitted therewith) is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 571-273-8300).

Date: September 26, 2006Michele Muller
(Name of person faxing paper)
(Signature of person faxing paper)

Attorney Docket No. FR-AM1888NP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PRADEL, Jean-Laurent, et al

Group Art Unit: 1772

Serial No.: 10/671,758

Examiner: PATTERSON, Marc A

Filed: September 26, 2003

For: " COEXTRUSION TIE FOR POLYESTER BASED ON COGRAFTED METALLOCENE
POLYETHYLENE AND LLDPE AND ON METALLOCENE POLYETHYLENE "PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Pre-Appeal Brief Request for Review accompanies our Notice of Appeal and fee, in reply to the Final Rejection dated July 26, 2006.

Attached are Applicant's arguments for which review is being requested.

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Issue

The issue is: **Can a foreign equivalent of a properly Terminally Disclaimed US patent be cited as a substitute valid 35 U.S.C. §103(a) reference in the same application?**

Prosecution history of present application:

09/27/2002 - FR 02.11992 application was filed in France as the priority document.

09/26/2003 - US patent application 10/671,758 filed, claiming priority to FR 02.11992.

02/08/2005 - First Office Action Rejection: §112 and double patenting rejections over US 6,528,587 in view of X, as the only rejections.

4/29/2006 - A response and terminal disclaimer over US 6,528,587 with proper fees filed.

7/26/2005 - Non-final rejection: over EP 1136536 (EP equivalent of terminally disclaimed US 6,528,587) using US 6,528,587 as the translation!

10/25/2006 - Response, claiming that a citation of the EP equivalent of the terminally disclaimer US case as prior art is improper.

01/12/2006 - Non-final rejection: over same EP 1136536 art.

06/12/2006 - Response (with 1-month extension fee) again arguing improper citation of the European equivalent of the US terminally disclaimed patent.

07/26/2006 - Final rejection, again based on EP 1136536.

Prosecution history of US 6,528,587 and EP 1136536

03/24/2000 - FR 0003797 was filed

03/16/2001 - EP 1,136,536 B1 was filed. Published September 26, 2001

03/26/2001 - US 6,528,587 B2 filed (first business day - Monday - after the 1-year anniversary of the priority document), and published December 20, 2001.

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REMARKS:

Applicant knows of no case law on point.

Applicant acknowledges that the EP 1136536 application, published one year and one day before Applicant's priority document, would be a valid prior art reference.

Applicant notes that the Examiner in this case recognizes the equivalence of the US 6,528,587 and EP 1136536 documents – since the Examiner uses the US patent as the English translation of the EP application.

Applicant, however, argues that it is improper to cite the EP equivalent of a US Terminally-disclaimed patent as substitute 35 U.S.C. §103(a) prior art for the following reasons:

- A. As against the stated purpose of a Terminal disclaimer.**
- B. As against public policy and international treaties**
- C. As against fairness.**

A. As against the stated purpose of a Terminal disclaimer

If a terminal disclaimer over a US patent is not also a terminal disclaimer over all foreign equivalent cases having the same priority date, then the terminal disclaimer ceases to function in the manner anticipated in the law. The main function of the Terminal Disclaimer is that it obviates the primary objection to double patenting, which is the extension of monopoly. In re Robeson, 331 F.2d 610, 141 USPQ 485 (1964). To accomplish this purpose, the terminal disclaimer should place the claims in the same position with respect to the EP ('536) subject matter as the US ('587). Since the present claims now terminate with the US ('587) patent claims, there is no monopoly extension over either US ('587) or the equivalent (EP '536).

The effect of a terminal disclaimer is to tie the affected patents together [Ortho Pharmaceutical Corp v. Smith, 959 F.2d 936, 22 USPQ 2d 1119, 1123 (Fed. Cir 1992)]. Tying the US patent, without also tying all foreign equivalent applications having the same priority, produces an incomplete tying.

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SEP 26 2006**A. As against public policy and international treaties**

One important purpose of a Terminal Disclaimer to public policy, as improvements are placed into the public domain. In this regard, the framers of the present regulations placed no limits on length of time that can be terminally disclaimed.

The effect of a terminal disclaimer that applies only to the US patent, and not to any foreign equivalents, in effect limits the use of a terminal disclaimer for any internationally filed patent, to only US cases filed less than 18 months prior to the application. Foreign patent applications publish at 18 months, making the disclaimer of any US patent older than 18 months and filed internationally a useless exercise. The Examiner could disregard any Terminal disclaimer over the US reference and cite the foreign equivalent as prior art instead.

The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. MPEP 804.02(II). *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

B. As against Fairness

A foreign equivalent of a US Terminally-disclaimed reference (with the same priority date) should not be allowed to be used as a substitute 35 U.S.C. §103 reference. The substitute of equivalent references makes a mockery of US Terminal Disclaimer practice, allowing Examiners to circumvent most Terminal Disclaimers. Once a US applicant decides to shorten the length of monopoly protection in exchange for removal or a prior art reference it is unfair for the Patent office to accept such a terminal disclaimer, then use a foreign equivalent patent to make the same arguments. This would amount to a taking of Applicant's property right without any consideration.


It is noted that the filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed.

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Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." MPEP 804.02 II

Applicant requests the Pre-Appeal committee to consider the arguments above as they relate to the substitution of a foreign equivalent patent reference for a Terminally-disclaimed US reference. If the Committee finds, as Applicant believes, that for various reasons the Foreign equivalent reference should not be substituted for a terminally-disclaimed US reference, then Applicant requests that rejections be removed, and the present application be allowed to pass to Allowance at this time.

Respectfully submitted,



Thomas F. Roland, Esq.
Attorney for the Applicants Reg. No. 42,110
Customer Number 31684

Date: September 26, 2006